

## REMARKS/ARGUMENTS

Claims 2, 3, 6, 8, 9, 13, and 14 are pending. The Examiner has rejected all of the pending claims. Applicant respectfully traverses the rejection for the reasons set forth below.

### **I. Response to Rejection Under 35 U.S.C. § 103**

Claims 2, 3, 6, 8, 9, 13, and 14 are rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,769,625 to Sher ("Sher") in view of U.S. Patent No. 5,655,902 to Doucet ("Doucet").

Applicant respectfully traverses the Examiner's rejection because the Examiner has not established a *prima facie* ground for rejection.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142. The analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

In evaluating the prior art, references must be read as a whole. There can be no finding of obviousness where a reference teaches away from the proposed modification or combination, or where the proposed modification or combination would destroy the functionality of the reference for its own purpose. *See Gillette v. S.C. Johnson*, 919 F.2d 720, 724 (Fed. Cir. 1990);

*In re Geisler* 116 F.3d 1465, 1469 (Fed. Cir. 1997); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Since inventions often tend to be notoriously easily understood in hindsight, the law has repeatedly warned against the dangers of hindsight analysis. One protection against hindsight analyses is that the law requires that references be read as a whole: it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238; 147 U.S.P.Q. 391 (CCPA 1965).

Such picking and choosing appears to be what the Examiner has done in evaluating the cited references. In rejecting the claims, the Examiner has stated:

8. Sher, as discussed above, discloses the invention as claimed with the exception of showing the discs having a diameter larger than the striker wheel (Figure 5).

9. Doucet discloses a similar lighter, having a striker wheel (20) surrounded by two discs (18) in the same manner as Sher and applicant. Doucet teaches placing a sleeve (60) as part of the striker wheel to prevent children from activating the lighter. As seen in Figure 4, the sleeve surrounding the striker wheel has the same diameter as the outer discs.

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher striker wheel to include the sleeve of Doucet, in order to prevent children from operating the lighter (col. 1, lines 11-13).

Contrary to the Examiner's statement, however, upon reading the references as a whole, it would **not** have been obvious to one of ordinary skill in the art to combine the teachings of Sher and Doucet to provide the Applicant's claimed invention. The structure and operation of the lighter in Sher are entirely different from those of the lighter in Doucet. Sher utilizes a child safety mechanism that is wholly different from the child safety mechanism utilized in Doucet.

The lighter in Sher requires a striker wheel having an annular recessed center portion and annular unrecessed lateral portions, where the surfaces of annular unrecessed lateral portions of the striker wheel are smooth so that only an adult's finger (but not a child's finger) can operate the striker wheel for ignition. *See* col. 1 line 64 – col. 2 line 39 of Sher. Sher distinguishes its lighter from prior art on the ground that the surfaces of annular unrecessed lateral portions of the striker wheel in Sher are smooth whereas the striker wheel in prior art has protuberances on the surfaces of annular unrecessed lateral portions. *See* col. 4 lines 35-45 of Sher. Further, Sher teaches that the striker wheel is mounted to the lighter in slots such that the striker wheel is pressed from a first position having insufficient spring force to ignite into a second position having sufficient spring force to cause the lighter flint to spark when the striker wheel is rotated. *See* Abstract of Sher.

Different from Sher, the lighter in Doucet requires a slip ring (referred as "sleeve" by the Examiner), which is concentrically mounted about a striking wheel assembly, to resist undesired use of the lighter by young children. *See* Abstract and col. 1 lines 4-8 of Doucet. The slip ring in Doucet rotates freely about the striking wheel assembly and has an elongated channel so that the ends of the slot engage a flint housing to limit the range of motion of the slip ring. *See* Abstract and col. 2 lines 33-35 of Doucet. Doucet teaches that the exterior surface of the slip ring is preferably serrated to provide a rough edge for engagement by the user's finger. *See* col. 3 lines 34-36 of Doucet. To operate the lighter in Doucet, at least a threshold amount of pressure exerted by a finger or thumb be applied to the slip ring which surrounds the striking wheel assembly before the striking wheel assembly can be rotated against flint to create a spark. *See* col. 1 line 67 – col. 2 line 5 of Doucet.

Although the structure and operation of the lighter in Sher are entirely different from those of the lighter in Doucet, the Examiner has failed to provide any articulated reasoning and rational underpinning to support his conclusion of obviousness as to how and why a person of ordinary skill in the art would have combined such entirely different structures. Contrary to the Examiner's conclusion, the different structures and operations of the two lighters as taught in the two references teach away from combining Sher with Doucet, and such combination would destroy the functionality of the lighter of Sher for its own purpose. If such a slip ring as in Doucet were to be installed in the lighter of Sher, it would obstruct operation of the lighter of Sher and would add excessive and improper difficulty in rotating the sparker wheel. Moreover, the slip ring of Doucet cannot be properly incorporated in the lighter of Sher because the sparker wheel of Sher is vertically movable from one position to another, thereby incapable of providing a structure for limiting the range of motion of the slip ring.

Accordingly, it would **not** have been obvious to one of ordinary skill in the art to combine the teachings of Sher and Doucet to provide the Applicant's claimed invention. Applicant respectfully requests the Examiner to withdraw the 103 rejection.

Even if it be assumed that Sher and Doucet are combined, Applicant's claim limitations would still be missing from the resulting combination. Specifically, contrary to the Examiner's statement, the slip ring (sleeve) of Doucet does not have the same diameter as the outer discs (18). As clearly shown in figures and described in specification of Doucet, the slip ring has a larger diameter than those of the outer discs. Doucet teaches that the slip ring "surrounds" the striking wheel assembly including the outer discs and that pressure exerted by a finger or thumb should be applied to the slip ring "before" the striking wheel assembly can be rotated against the flint. *See* col. 2 lines 1-5 of Doucet. Moreover, the surface of the slip ring of Doucet, on which a

user's finger or thumb contacts, is rough whereas the surfaces of the circular discs of Applicant's invention are glossy.

For at least the above reasons, the Examiner has not established a *prima facie* case of obviousness with respect to Applicant's pending claims over Sher in view of Doucet. Accordingly, Applicant respectfully requests the Examiner to withdraw the obviousness rejection.

### **CONCLUSION**

The Examiner is respectfully requested to reconsider his position in view of the remarks and arguments made herein. It is believed that claims 2, 3, 6, 8, 9, 13, and 14 have been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

Respectfully submitted,

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